

ESTTA Tracking number: **ESTTA435352**

Filing date: **10/12/2011**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Swatch AG (Swatch SA) (Swatch Ltd.)
Granted to Date of previous extension	10/12/2011
Address	94, rue Jakob Stämpfli Biel/Bienne, CH-2502 SWITZERLAND
Attorney information	Jess M. Collen Collen IP, Intellectual Property Law, P.C. The Holyoke-Manhattan Building 80 South Highland Avenue Ossining, NY 10562 UNITED STATES dewen@collenip.com, docket@collenip.com

Applicant Information

Application No	85073174	Publication date	06/14/2011
Opposition Filing Date	10/12/2011	Opposition Period Ends	10/12/2011
Applicant	Boutique Newcity (Public) Company Limited 1112/53-75 Sukhumvit Rd. Soi Sukhumvit 48, Prakanong Klongtoey Bangkok, 10110 THAILAND		

Goods/Services Affected by Opposition


Class 025. All goods and services in the class are opposed, namely: Women's clothing, namely, jackets, blouses, shirts, skirts, pants, tank tops and dresses

Grounds for Opposition


Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1356512	Application Date	11/02/1984
Registration Date	08/27/1985	Foreign Priority Date	NONE
Word Mark	SWATCH		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 014. First use: First Use: 1982/05/31 First Use In Commerce: 1982/05/31 WATCHES AND PARTS THEREOF

U.S. Registration No.	1671076	Application Date	07/17/1990
Registration Date	01/07/1992	Foreign Priority Date	NONE
Word Mark	SWATCH		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 014. First use: First Use: 1981/11/12 First Use In Commerce: 1981/11/12 watches, clocks and parts thereof		

U.S. Registration No.	1799862	Application Date	02/21/1992
Registration Date	10/19/1993	Foreign Priority Date	NONE
Word Mark	SWATCH		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1991/11/00 First Use In Commerce: 1992/03/20 retail store services; namely, retail shops featuring watches, watch parts and watch accessories		


U.S. Registration No.	1849657	Application Date	02/21/1992
Registration Date	08/09/1994	Foreign Priority Date	NONE
Word Mark	SWATCH		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 042. First use: First Use: 1993/11/26 First Use In Commerce: 1993/11/26 retail store services; namely, retail shops featuring, sunglasses and electronics

U.S. Registration No.	1980517	Application Date	09/27/1994
Registration Date	06/18/1996	Foreign Priority Date	NONE
Word Mark	SWATCH		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1986/00/00 First Use In Commerce: 1986/00/00 T-shirts, neckties, scarves and caps		

U.S. Registration No.	2752980	Application Date	04/26/2002
Registration Date	08/19/2003	Foreign Priority Date	NONE
Word Mark	SWATCH		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 014. First use: First Use: 2000/08/00 First Use In Commerce: 2000/08/00 Jewelry, namely, earrings, necklaces, pendants, bracelets and rings		

U.S. Registration No.	2050210	Application Date	03/06/1995
Registration Date	04/08/1997	Foreign Priority Date	NONE
Word Mark	SWATCH		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 016. First use: books and periodicals, namely a series of books illustrating collectable articles; magazines for watch collectors

U.S. Registration No.	2100605	Application Date	09/28/1994
Registration Date	09/30/1997	Foreign Priority Date	NONE
Word Mark	SWATCH		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 006. First use: ((metal keychains)) Class 009. First use: [optical spectacles and sunglasses, frames for spectacles, cases for spectacles, spectacle retaining cords and spectacle retaining chains] Class 016. First use: pens, ((pencils, and markers)) Class 018. First use: suitcases, travel bags, ((cosmetic cases (sold empty), briefcase-type portfolios, briefcases, wallets,)) handbags, ((keyholders, vanity cases (sold empty),)) umbrellas, ((and parasols)) Class 020. First use: non-metal keyholders Class 028. First use: ((toys watches, balloons, toy balls, toy flying disks; toys and sporting goods, namely golf balls, tennis balls, volley balls, soccer balls, flippers for swimming, golf bags, and clubs, golf gloves, ice skates, roller skates, and in-line skates, skateboards, surfboards, elbow guards and knee guards))		

U.S. Registration No.	3799562	Application Date	12/13/2002
Registration Date	06/08/2010	Foreign Priority Date	NONE
Word Mark	SWATCH		
Design Mark			
Description of Mark	NONE		

Goods/Services	<p>Class 003. First use: PERFUMES; COLOGNES; COSMETICS</p> <p>Class 008. First use: Razors</p> <p>Class 009. First use: Sunglasses; case for spectacles; leather eyeglass cases; spectacle retaining cords, and spectacle retaining chains; multifunction telecommunication apparatus; namely, combination telephone and answering machine, combination watch and computer; apparatus for telecommunication, transmission, reception, recording, and reproduction, namely, radios, telephones, televisions, audio, video, tape and cassette players and recorders; phonograph records and pre-recorded audio compact discs, tapes, and cassettes, all featuring music; pre-recorded video discs, tapes, and cassettes of athletic events, scientific and nautical apparatus, namely, satellite navigational systems, beepers, surveying apparatus, namely, surveying chains; photographic and cinematographic apparatus, namely, photographic cameras, cinematographic film; optical apparatus, namely, optical scanners, weighing apparatus, namely, scales and calibrating equipment; measuring apparatus, namely, lasers and pocket calipers for measuring purposes; signaling apparatus, namely, signal whistles, life saving apparatus, namely, life saving rafts; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, namely, electric converters, electric transformers, voltage regulators for electric power, electric switches; apparatus for recording, transmission or reproduction of sound or image, namely, juke boxes, audio tape recorders, video tape recorders, video monitors</p> <p>Class 011. First use: APPARATUS FOR LIGHTING, NAMELY, ELECTRIC LIGHTING FIXTURE, WATER PUMPS FOR SPAS, BATHS, WATER FILTERING UNITS</p> <p>Class 014. First use: WATCH PROTECTORS; WATCHCASES; NECK CHAINS</p> <p>Class 015. First use: MUSICAL INSTRUMENTS</p> <p>Class 016. First use: Paper, namely, bags, envelopes, covers, folders, note paper, art paper, carbon paper; photographs; albums, balls for ball point pens, booklets, books, boxes of cardboard or paper, calendars, cardboard articles and tubes, greeting cards, printed publications, namely, catalogues, magazines, manuals, and periodicals all in the field of horology and jewelry; printed timetables; clips for offices, folders for papers, postcards, notebooks, photograph stands, posters, prints, rubber erasers, table cloths, table mats, table linen, table napkins of paper, stationery; artist's materials, namely, pastels, pencils, paint brushes, painter's brushes; paper clasps, paper clips, crayons, pen cases, pencil and pen holders, pens and pencils, pencil sharpeners, wrappers, wrapping paper, writing cases, wristbands for retention of writing instruments</p> <p>Class 018. First use: Suitcases, travel bags, briefcase-type portfolios, briefcases, wallets, handbags, umbrellas, parasols, canes, backpacks, shoulder bags, cases of leather, namely, leather attache cases, purses, rucksacks, shopping bags</p> <p>Class 020. First use: FURNITURE; NON-METAL KEY HOLDERS; CHAIRS</p> <p>Class 021. First use: HOUSEHOLD OR KITCHEN UTENSILS NOT OF PRECIOUS METAL OR COATED THEREWITH, NAMELY, POT AND PAN SCRAPERS, ROLLING PINS, SPATULAS, TURNERS, WHISKS, HOUSEHOLD OR KITCHEN CONTAINERS NOT OF PRECIOUS METAL OR COATED THEREWITH; HAIR</p>
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	<p>COMBS; SPONGES FOR HOUSEHOLD PURPOSES; HAIR BRUSHES; BRUSH-MAKING MATERIALS; ARTICLES FOR CLEANING PURPOSES, NAMELY, CLEANING RAGS, IMPREGNATED CLEANING, DUSTING OR POLISHING CLOTHS, STEEL WOOL FOR CLEANING; BEVERAGE GLASSWARE; PORCELAIN FIGURINES, PORCELAIN MUGS; EARTHENWARE MUGS</p> <p>Class 022. First use:</p> <p>Ropes, string, tents, awnings not made of metal; tarpaulins, sails, nets, namely, commercial nets, fabric and polyester mesh net used for storing toys and other household items, hammocks</p> <p>Class 024. First use:</p> <p>Towels, handkerchiefs, bed blankets, shower curtains, table cloths not of paper, table mats not of paper</p> <p>Class 025. First use:</p> <p>DOWN VESTS; WIND RESISTANT JACKETS; SKI BOOTS</p> <p>Class 028. First use:</p> <p>BOARD GAMES, GYMNASTIC AND SPORTS ARTICLES, NAMELY SKIS, SKI POLES, PORTABLE COVERS AND CASES FOR SKIS AND SKI BINDINGS, TENNIS RACKETS, TENNIS BALLS, TENNIS RACKET CASES AND COVERS, KITES, BALLS OF ALL KINDS, TOY FIGURES, SOFT-SCULPTURED DOLLS, AND STUFFED TOYS, TOY VEHICLES, SKATE BOARDS, ROLLER SKATES, BALLOONS, JIGSAW PUZZLES TOY WATCHES, TOY JEWELRY, CHRISTMAS TREE DECORATIONS, YOYOS, AND PLAYING CARDS</p> <p>Class 029. First use:</p> <p>MEATS AND PROCESSED FOODS, NAMELY, MEAT, CHICKEN, PROCESSED FRUITS AND VEGETABLES, CLAM CHOWDER</p> <p>Class 032. First use:</p> <p>BEVERAGES, NAMELY, FRUIT JUICE, VEGETABLE JUICE, CARBONATED SOFT DRINKS</p> <p>Class 034. First use:</p> <p>CIGARETTE AND CIGAR LIGHTERS NOT OF PRECIOUS METAL</p> <p>Class 035. First use:</p> <p>MANAGEMENT OF BUSINESS; ADVERTISING AGENCIES; COMPUTER ASSISTED PROCESSING OF DATA DERIVED FROM THE TIMING OF SPORTING ACTIVITIES FOR USE IN EDUCATION, ENTERTAINMENT AND PUBLICITY</p> <p>Class 038. First use:</p> <p>Electronic transmission of data derived from sporting events; and radio and television broadcast of programs and shows</p> <p>Class 041. First use:</p> <p>Providing of entertainment, namely, sporting and cultural activities</p>
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/David Ewen/
Name	David Ewen
Date	10/12/2011

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

Applicant : Boutique Newcity (Public) Company Limited
Serial No. : 85073174
Filed : June 28, 2010
For : **sw i t ch**
Published : June 14, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE
Commissioner for Trademarks
Box TTAB-Fee
P. O. Box 1451
Alexandria, VA 22313-1451

NOTICE OF OPPOSITION

Opposer Swatch AG (Swatch SA) (Swatch Ltd.), a corporation duly organized and existing under the laws of Switzerland, located at 94, rue Jakob Stämpfli, CH-2502 Biel/Bienne, Switzerland (referred to as “Opposer”) believes it would be damaged by the mark shown in the above-identified application, and hereby opposes same, pursuant to 15 U.S.C. § 1063 and 37 C.F.R. § 2.104.

As grounds for opposition, it is alleged that:

(1) Opposer is and has been engaged in the sale and marketing of goods under the SWATCH trademark since a time prior to the date of first use alleged by Applicant in its application for registration.

(2) Since 1982, Opposer is and has been engaged in the sale and marketing in commerce of a variety of goods and services including watches, clocks, jewelry, clothing, retail store services, and a range of other goods and services all under its SWATCH trademarks. Opposer has accrued substantial common law rights through its continuous use of its SWATCH trademarks.

(3) Opposer is also the owner of numerous valid United States Trademark Registrations including, but not limited to:

SWATCH	Reg. No. 1,356,512
SWATCH	Reg. No. 1,671,076
SWATCH	Reg. No. 1,799,862
SWATCH	Reg. No. 1,849,657
SWATCH	Reg. No. 1,980,517
SWATCH	Reg. No. 2,752,980
SWATCH	Reg. No. 2,050,210
SWATCH	Reg. No. 2,100,605
SWATCH	Reg. No. 3,799,562

(Collectively, “the SWATCH Marks.”)

(4) Opposer's registrations are *prima facie* proof of ownership and use of the mark from the original date of filing of the application, pursuant to 15 U.S.C. 1057(b), and of the exclusive right to use the registered mark in commerce.

(5) Registration Nos. 1,356,512, 1,671,076, 1,252,863, 1,799,862, 1849657, 2,100,605 and 2,050,210 are incontestable, pursuant to Section 15 of the Trademark Act.

(6) Opposer has used the SWATCH Marks in commerce extensively, and the SWATCH Marks have acquired considerable and valuable goodwill and wide-scale recognition. Opposer has used the SWATCH Marks on a wide array of goods and services over the years, including articles of clothing and accessories. The public has come to associate the SWATCH Marks with Opposer and Opposer's goods and services. The SWATCH Marks have acquired distinctiveness.

(7) Upon information and belief, Applicant's SWITCH (stylized) mark ("SWITCH Mark") is confusingly similar to Opposer's SWATCH trademarks, and is likely to cause confusion or mistake, or to deceive, when applied to Applicant's goods.

(8) Upon information and belief, consumers encountering Applicant's SWITCH Mark on goods in Class 25 are likely to believe that such goods originate from, or are authorized or sponsored by, Opposer.

(9) Upon information and belief, Applicant's SWITCH Mark will appear highly similar to Opposer's SWATCH Marks, as the parties' marks differ by only one letter.

(10) Upon information and belief, Applicant's SWITCH Mark is pronounced in a way that is highly similar to Opposer's SWATCH Marks.

(11) Upon information and belief, Applicant is using and/or intends to use its SWITCH Mark on goods that are identical and/or highly related to those goods and services on which Opposer uses its SWATCH Marks, which includes goods in Class 25.

(12) Upon information and belief, Applicant offers/intends to offer goods bearing its SWITCH Mark through channels of trade that are identical and/or highly similar to those through which Opposer's goods and services travel.

(13) Upon information and belief, Applicant adopted its SWITCH Mark with knowledge of Opposer's SWATCH Marks.

(14) Opposer's SWATCH Marks are famous.

(15) Opposer's SWATCH Marks became famous at a time prior to Applicant's date of first use, and date of application to register, the SWITCH Mark.

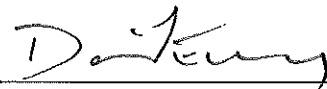
(16) Upon information and belief, the Applicant's mark is likely to diminish and dilute the value and distinctive character of the Opposer's mark.

(17) Registration of Applicant's SWITCH Mark would cause irreparable harm to Opposer by creating a likelihood of confusion with, and/or diluting the distinctiveness of, Opposer's SWATCH Marks.

WHEREFORE, Opposer prays that Application Serial No. 85/073174 be refused, that no registration be issued thereon to Applicant and that this Opposition be sustained in favor of Opposer.

Respectfully submitted,

By:



Jess M. Collen
David Ewen
COLLEN IP
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Ossining, NY 10562
Phone: 914-941-5668
Fax: 914-941-6091
Attorneys for Opposer

Date: October 12, 2011

Enclosure: Opposition fee \$300.00 per class (\$300.00)

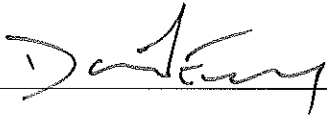
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SHOULD ANY OTHER FEE BE REQUIRED, THE PATENT AND TRADEMARK OFFICE IS HEREBY REQUESTED TO CHARGE SUCH FEE TO OUR DEPOSIT ACCOUNT 03-2465.

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING FILED ELECTRONICALLY WITH THE UNITED STATES PATENT AND TRADEMARK OFFICE.

By:

A handwritten signature in black ink, appearing to read "Daniel", written over a horizontal line.

Date: October 12, 2011

CERTIFICATE OF SERVICE

I, David Ewen, hereby certify that on October 12, 2011, I caused a true and correct copy of the foregoing Notice of Opposition to be served upon Applicant, and Applicant's Attorney of Record, via first class mail, postage pre-paid, at the following addresses:

Boutique Newcity (Public) Company Limited
1112/53-75 Sukhumvit Rd.
Soi Sukhumvit 48, Prakanong
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THAILAND

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